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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/790,775   | 03/03/2004  | Ippei Nakamura       | 003510-149          | 3211             |
| 21839  | 7590        | 09/07/2005           | EXAMINER            |                  |
| BUCHANAN INGERSOLL PC<br>(INCLUDING BURNS, DOANE, SWECKER & MATHIS)<br>POST OFFICE BOX 1404<br>ALEXANDRIA, VA 22313-1404 |             |                      | WALKE, AMANDA C     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     | 1752             |

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/790,775             | NAKAMURA, IPPEI     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Amanda C. Walke        | 1752                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 June 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 24-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 28 and 29 is/are allowed.

6)  Claim(s) 24 is/are rejected.

7)  Claim(s) 25-27 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. 09/871,724.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

This action is in response to the amendment to the specification and arguments filed 6/23/2005.

Claims 24-29 are pending, 24 being rejected, 25-27 being objected to as being dependent upon a rejected base claims (the rejection of claim 25 is being withdrawn for the reasons listed below), and 28 and 29 indicated as being allowable.

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 6/23/2005 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Ukai et al (4,555,481).

The benzimidazolocarbocyanine dyes represented by general formulae (I) and (II) (claim 1) each meet the present limitations for the infrared absorber comprising a fluorine-containing substituent which has at least 5 fluorine atoms when a is 3 to 6 (formula (I)) and m is 2 to 8 (formula (II)). For example, see compounds I-6. It is the Examiner's position, the cyanine dyes of Ukai et al. are inherently infrared absorbing because of the structural similarities to other infrared absorbing cyanine dyes. MPEP 2112.

***Allowable Subject Matter***

4. Claims 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest to one of ordinary skill in the art to prepare the material of the instant claim 24 wherein an infrared absorber meeting the structural requirements of the instant claims 25-27 is present.

5. Claims 28 and 29 are allowed.

6. The prior art of record fails to teach or suggest to one of ordinary skill in the art to prepare the material of the instant claim 28 or 29 wherein an infrared absorber meeting the structural requirements of the instant claims is present.

***Response to Arguments***

7. Applicant's arguments filed 6/23/2005 have been fully considered but they are not persuasive. Applicant has argued that the Ukai et al reference fails to meet the instant claim limitations as Examiner Gilliam's reasoning is deemed appropriate with respect to this reference teaching the claimed compound. The instant claim 24 simply requires an infrared absorbing compound having a fluorine-containing substituent having at least 5 fluorine atoms. The compound and teachings cited by the examiner appear to meet this limitation, therefore the rejection is maintained.

With respect to the rejection of claims 24 and 25 over the JP 2000-289341 reference, given the arguments presented by the examiner and the translated foreign priority document, the reference is not applicable as it was published after the priority date of the instant application.

***Conclusion***

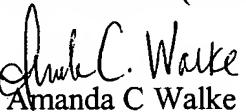
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C. Walke whose telephone number is 571-272-1337. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Amanda C. Walke  
Examiner  
Art Unit 1752

ACW  
September 3, 2005